

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Kristof Van Emelen et al.

Application No.: 10/507,159

Confirmation No.: 8973

Filed: September 8, 2004

Art Unit: 1626

For: SULFONYLAMINO-DERIVATIVES AS
NOVEL INHIBITORS OF HISTONE
DEACETYLASE

Examiner: K. A. Saeed

**APPLICATION FOR PATENT TERM ADJUSTMENT INCLUDING REQUEST FOR
RECONSIDERATION UNDER 37 CFR §1.705(b)**

MS Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

1. This is a request for reconsideration of the patent term adjustment of 990 days indicated in the determination of Patent Term Adjustment under 35 USC 154(b) that was attached to the Notice of Allowance mailed on December 15, 2009 for the above-referenced application. It is respectfully requested that Applicants be granted a minimum patent term adjustment of **1623 days**, with an adjustment term based on the number of days following payment of the issue fee on March 15, 2010 to the date of issuance of a patent for the above-referenced application.
2. This request is being submitted along with an updated Power Of Attorney and Change of Correspondence Address.
3. Applicants submit herewith a "Statement Under 37 CFR§ 1.702(b)."

4. In accordance with 37 CFR§ 1.705(b)(1), please charge our Credit Card in the amount of \$200.00 covering the fees set forth in 37 CFR §1.18(e). The U.S. Patent and Trademark Office is authorized to charge any additional fees that may be required in conjunction with this submission to Deposit Account Number 50-2228, under Order No. 026038.0274PTUS, from which the undersigned is authorized to draw.

Dated: March 12, 2010

Respectfully submitted,

By 

B. Dell Chism

Registration No.: 60,464

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STATEMENT UNDER 37 CFR § 1.702(b)

MS Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

1. This statement is respectfully submitted in support of the "Application for Patent Term Adjustment Including Request for Reconsideration Under 37 CFR § 1.705(b)" for the above-referenced application. In view of the following, it is respectfully requested that Applicants be granted a minimum patent term adjustment of 1623 days, with an adjustment term to be based on the number of days following payment of the issue fee on March 15, 2010 to the date of issuance of a patent for the above-referenced application.

2. The patent term adjustment on the Determination of Patent Term Adjustment Under 35 U.S.C. §154(b) that was attached to the Notice of Allowance is 990 days (a copy of the PTAS Sheet is submitted herewith as Exhibit A). This determination of 990 days is in error in that

pursuant to 35 U.S.C. §154(b) the Office failed to properly account for the days lost to Patent Office Delays under 37 CFR § 1.702(a)(1) and § 1.703(a)(1), in conjunction with the Patent Office's delays in issuing a patent within three (3) years of filing the above-referenced application under 37 CFR § 1.702(b) and 1.703(b), as provided in *Wyeth v. Kappos*, ___ F.3d ___ (Fed. Cir. 2010).

3. Pursuant to 37 CFR § 1.702, the correct patent term adjustment should be 1623 days providing for a June 22, 2010 issuance date. The correct patent term adjustment of 1623 days accounts for the delay times for: i) failure of the Patent Office to issue a patent within three (3) years of the 35 U.S.C. § 371 National Stage Commencement date (filing date) of September 8, 2004, which totals a delay of 1018 days based on a June 22, 2010 issuance date; and ii) failure to provide a first action within fourteen (14) months of the 35 USC 371 completion date of September 13, 2004, wherein the first action was not received until June 27, 2008, which totals a delay of 957 days based on the fulfillment of the requirements of 35 USC § 371. The correct patent term adjustment of 1623 accounts for Applicant delays under 37 CFR § 1.704(b), wherein Applicants were debited a total of 59 days for failing to respond to the June 27, 2008 office action until November 25, 2008 (59 day delay). The correct patent term adjustment accounts for a total of 293 days of overlap regarding the differences between patent term extension periods under 37 CFR § 1.702(b), 1.703(b) and all other sections of Code regarding Patent Office Delays, which is set forth under 37 CFR § 1.703(f) regarding calculation of correct patent term adjustments.

4. The above-referenced application is not subject to any terminal disclaimers.

5. There were no circumstances constituting a failure to engage in reasonable efforts to conclude processing or examination of such application as set forth in 37 CFR § 1.704 beyond that discussed *supra*, regarding Applicants 59 days of delay for failing to respond to the June 27, 2008 office action until November 25, 2008.

6. As set forth in 37 CFR §1.703(f), Applicants are entitled to a period of patent term adjustment equal to the period of examination delays reduced by the period of Applicant Delay and examination delay overlap days. Therefore, Applicants submit that the correct patent term adjustment for the above-referenced application is **at least 1623 days**, which is the difference between the total period of examination delay (1975 days) and the period of Applicant Delay (59 days) and the period of examination delay overlap days (293 days). Applicants further submit that the term of 1623 days should be adjusted by a term equal to the number of days following payment of the issue fee on March 15, 2010 to the date of issuance of a patent for the above-referenced application in accordance with 37 CFR §1.703(b) (noting that Applicant based the 1623 day adjustment on a June 22, 2010 issuance date). **As such, the correct patent term adjustment upon issuance of a patent is expected to be the sum of 1623 days (as calculated herein) and adjusted for the number of days from March 15, 2010 to issuance of a patent.**

7. In accordance with 37 CFR§ 1.705(b)(2)(iii), Applicants submit that the pending patent corresponding to this application will not be subject to a terminal disclaimer.

In view of the foregoing, it is respectfully requested that this Application for Patent Term Adjustment be favorably considered and that a corrected Determination of Patent Term Adjustment be issued to reflect a minimum patent term adjustment of 1623 days, with an

adjustment to be based on the number of days following payment of the issue fee on March 15, 2010 to the date of issuance of a patent for the above-referenced application.

Dated: March 12, 2010

Respectfully submitted,

By



B. Dell Chism

Registration No.: 60,464

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McLean, Virginia 22102

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Attorney for Applicant

ATTACHMENTS:

- (a) Determination of Patent Term Adjustment under 35 U.S.C. §154(b)

10/507,159	SULFONYLAMINO-DERIVATIVES AS NOVEL INHIBITORS OF HISTONE DEACETYLASE	03-12- 2010::17:40:09
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Patent Term Adjustments

Patent Term Adjustment (PTA) for Application Number: 10/507,159

Filing or 371(c) Date:	09-08-2004	USPTO Delay (PTO) Delay (days):	-
Issue Date of Patent:	-	Three Years:	-
Pre-Issue Petitions (days):	-	Applicant Delay (APPL) Delay (days):	-
Post-Issue Petitions (days):	-	Total PTA (days):	990
USPTO Adjustment(days):	-	Explanation Of Calculations	

Patent Term Adjustment History

Date	Contents Description	PTO(Days)	APPL(Days)
12-15-2009	Mail Notice of Allowance		
12-11-2009	Document Verification		
12-10-2009	Notice of Allowance Data Verification Completed		
12-10-2009	Case Docketed to Examiner in GAU		
12-10-2009	Examiner's Amendment Communication		
11-13-2009	Date Forwarded to Examiner		
09-15-2009	Response after Non-Final Action		
06-25-2009	Mail Non-Final Rejection	92	
05-12-2009	Mail-Record Petition Decision of Granted Related to Inventor in Patent	⬆	
05-11-2009	Record Petition Decision of Granted Related to Inventor in Patent	⬆	
01-15-2009	Petition Entered	⬆	
02-17-2009	Non-Final Rejection	⬆	
10-10-2006	Information Disclosure Statement considered	⬆	
12-01-2008	Date Forwarded to Examiner	⬆	
11-25-2008	Response to Election / Restriction Filed		59
11-25-2008	Request for Extension of Time - Granted		⬆
06-27-2008	Mail Restriction Requirement	957	
06-23-2008	Requirement for Restriction / Election	⬆	
06-12-2008	Case Docketed to Examiner in GAU	⬆	
11-21-2007	Transfer Inquiry to GAU	⬆	
10-10-2006	Information Disclosure Statement (IDS) Filed	⬆	
04-26-2005	Cleared by OIPE CSR	⬆	
04-26-2005	Cleared by OIPE CSR	⬆	
04-26-2005	Cleared by OIPE CSR	⬆	
04-26-2005	Cleared by OIPE CSR	⬆	
04-26-2005	Cleared by OIPE CSR	⬆	
09-13-2004	371 Completion Date	⬆	
04-14-2005	Application Dispatched from OIPE		
04-14-2005	Notice of DO/EO Acceptance Mailed		
02-11-2005	Notice of DO/EO Missing Requirements Mailed		

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